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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,285	03/05/2002	Jay R. Patel	1199486.US	3141

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EXAMINER

SALIMI, ALI REZA

ART UNIT PAPER NUMBER

1648

DATE MAILED: 07/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**Application No.  
**10/070,285**Applicant(s)  
**Patel Jay R.**Examiner  
**A. R. SALMI**Art Unit  
**1648**

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Jun 3, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-22 is/are pending in the application.
- 4a) Of the above, claim(s) 15-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 6) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restriction***

Applicant's election with traverse of Group I (Claims 6-14) in Paper No. 9 is acknowledged. However, since no argument was set forth by the applicant the election was treated as an Election **without** traverse. Hence, claims 15-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected. Claims 6-14 are considered.

**Applicant is reminded to cancel the claims to the non elected claims.**

### ***Specification***

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

### ***Claim Rejections - 35 USC § 112***

Claims 6-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 6 is vague and indefinite for recitation of "non-toxic mutagen", the intended mutagen is not defined. Is SDS intended? In addition, claim is confusing for recitation of "about", the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Does 30 or 37 degree Celsius falls within the limitations of "about" ? This affects the dependent claims 7-14.

***Claim Rejections - 35 USC § 112***

Claim 7 is rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is not enabling for the said claims. The specification does not provide a repeatable method for obtaining an  
EHV-1, and it does not appear to be readily available material. Deposit of virus strains of <sup>EHV-1</sup>RSVs would satisfy the enablement requirements of 35 U.S.C. 112. Applicant's deposit statement on specification page 1 is noted, however, the statement does not indicate the extent of public availability.

If a deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or her signature, stating that the deposit has been made under the terms of the Budapest Treaty and that **all restrictions**

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**imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent, would satisfy the deposit requirements.**

See 37 CFR 1.808.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6, 8, 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Boxall et al (GB 1,570,732).

The claimed invention is anticipated by the claims and teaching of Boxall et al. The serial passage limitation reads on non-toxic mutagen, since serial passaging is a non-toxic form of inserting mutagenicity into a virus. The limitation of 33 degree C meets the limitation of "about" 34 degree C (see for example claims 1, 2, 3, and 13).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boxall et al (GB 1,570,732) and Halle Sidney (Journal of Virology, Oct. 1968, pages 1228-1229).

Boxall et al taught a process producing an attenuated temperature sensitive equine herpesvirus (see the claims). This differs since they did not use a chemical mutagen.

Halle taught the mutagenic effect of 5-Azacytidine wherein incubation of a virus such as Arbovirus with the said mutagen would render a mutation into the said virus. This differs since they did not use equine herpesvirus.

However, one of ordinary skill in the art at the time of filing would have been motivated by the above cited art to produce temperature sensitive equine herpesvirus to be utilized in vaccine production or detection assay. The above cited art taught a method of producing temperature sensitive of equine herpesvirus as taught by Boxall et al, and a chemical mutagen that can be used to insert a mutation within the virus genome as taught by Halle. One of ordinary skill in the art at the time of filing being familiar with above cited art would not have anticipated any unexpected results as none have been provided. Therefore, the invention as a whole is prima facie obvious absent unexpected results.

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***Subject Matter Free of Prior art***

Claim 7 is deemed free of prior art, given failure of the prior art to teach or reasonably suggest the specific EHV-1 having Accession No. 99061001.

No claims are allowed.

***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. R. Salimi whose telephone number is (703) 305-7136. The examiner can normally be reached on Monday-Friday from 9:00 Am to 6:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. The fax phone number for this Group is (703) 305-3014, or (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A. R. Salimi

7/18/2003

  
ALI R. SALIMI  
PRIMARY EXAMINER